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09/761,340	01/16/2001	Neil E. Morrow	KMOR116839	5973

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 20

Application Number: 09/761,340  
Filing Date: January 16, 2001  
Appellant(s): MORROW ET AL.

\_\_\_\_\_  
Laura A. Cruz  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**  
**MAY 14 2003**  
**GROUP 3700**

This is in response to the appeal brief filed April 15, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 58,59,68, and 97-102; 57,58,60,61,65,68,69,72,97,98, and 102; 57-59,65,68, and 69; and 99-101 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

5,060,403	BATTISTELLA et al.	10-1991
4,360,979	SPADEMAN	11-1982

4,969,278

OTTIERI

11-1990

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

1. Claims 68,99-102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 58,59,97 and 98 has been withdrawn in view of applicant's remarks.

The term "unrestrained" used in claims 99,100, and 101 is unclear, inaccurate and indefinite. The cable or the cable portion as claimed is under tension and therefore is not unrestrained at any portion of the cable.

Claim 68 is unclear and indefinite. It is not clear what "first and second locations" of the front portion "are substantially adjacent each other". What locations is applicant referring to?

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 57,58,60,61,65,68,69,72,97,98,102 rejected under 35 U.S.C. 102(b) as being anticipated by US 5060403 (Battistella).

Battistella teaches several embodiments of a ski boot having structure substantially as claimed including a forward lean system (see figure 1 which shows the front and rear quarters (3,4) in a forward lean position relative to the shell 2) comprising medial and lateral side cables (cable) causing forward flexing of the boot (see col. 4, lines 27-31 and col. 4, lines 64-68. The cables (6) of Battistella extend on both sides of the boot and therefore would include the medial side of the boot. Battistella also teaches a tension adjustment member (5,119,219, etc). The cables (6) are all attached to the forward portion of the boot at only one at one general position (the cable extends through opening 9). Also see figure 7 which shows the cable attached to the medial side of the boot about guide 207 of the shell.

Regarding claim 72, the opening 9 of Battistella serves as the "loop back".

Regarding claims 97 and 98, the opening 9 of Battistella is located at either the lateral and medial side of the boot, as claimed, see figures 2 and 4 which show the opening 9 on one side of the boot.

Regarding claim 102, the "only single general position" would be the instep area of the boot as best shown in figures 2 and 4.

All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying

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structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

4. Claims 57,58,59,65,68,69 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4360979 (Spademan).

Spademan teaches a ski boot having structure substantially as claimed including causing forward flexing of the boot (see col. 5, lines 42-49). Spademan also teaches a tension adjustment member (buckle). The cables are all attached at only one general position of the forward portion of the boot. Also see figure 1 which shows the cable attached to the medial side of the boot about the buckle. The cable extends on both side of the boot. A marked-up copy of Spademan has been attached to this office action.

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All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

5. Claims 99-101 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4969278 (Ottieri).

Ottieri teaches a ski boot having structure substantially as claimed, see the marked up copies of figure 1 and 2 attached.

The preamble limitation of a "snowboard boot" (claim 99), a "step-in snowboard boot" (claims 100,101) is only a statement of preferred or intended use. There is no

structure or any other recitation in the body of the claim that would give life, scope or meaning to the preamble recitation of these terms.

All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. The cable or cable portions remain "**unrestrained**" when in the open position as shown in figure 3.

**(11) Response to Argument**

Rejection of Claims 58,59,68 and 97-102 under 35 U.S.C. 112

Appellant argues "Claims 99, 100, and 101 meet the standard articulated in *Solomon* because the claims recite that the cable portions extend from guide to guide



unrestrained. Thus, for example, in claim 99, the cable portion extending between the second to the third guide is unrestrained. The term 'unrestrained' is understood when read in the context of the claim. The scope and meaning of the claims is evident when taken in the context of the specification and FIGURES 1 and 3, in particular, showing the cable portion extending from guide 140 to guide 132 with no other intervening guides."

In response, the examiner understands when applicant using the language "the cable portion extending from guide 140 to guide 132 with no other intervening guides". However, applicant is using the term "unrestrained" which does not mean the same thing. This term does not imply that there are no other intervening guides. Moreover, the cable is not unrestrained between the two guides since it is under tension and since the cable is applied over the front curvature of the boot. The cable is not merely floating freely between the two guides but is under tension and is guided by the front curvature of the boot. Therefore, claims 99-101 are indefinite.

With respect to claims 97-98, the examiner has withdrawn this rejection in view of appellant's remarks.

With respect to claim 68, appellant argues that this claim reads on figure 36 of the present application.

In response, figure 36 a species non-elected species. Appellant elected species I (figures 13-16) without traverse in paper #5. Therefore, it is not clear how claim 68 reads on the elected embodiment.

With respect to claims 58 and 59, the examiner has withdrawn this rejection in view of appellant's remarks.

Rejection of Claims 57,58,60,61,65,68,69,72,97,98, and 102 under 35 U.S.C. 102(b)

Appellant argues Battistella reference "describe only a single cable on only one side of the boot, in direct contrast to the claims having both a medial and a lateral cable."

In response, the cable of the present invention is only a single cable. The appellant has referred to the cable as a "medial and lateral cable members" in claim 57 but not as two separate and distinct cables. If this were the case then the claims would not read on the embodiment described and shown in figures 13-16.

Appellant argues that Battistella doesn't teach a forward lean system.

In response, all ski boots are have the uppers leaning forward, see figure 1, and therefore are a forward lean system. See figure 1, which shows the front and rear quarters (3,4) in a forward lean position relative to the shell 2 and see col. 4, lines 27-31 and col. 4, lines 64-68. Moreover, the system of Battistella is an adjustable closure device that surrounds the leg of the wearer attached to the upper quarters (3,4) and is connected to the shell (2) at the instep area and therefore naturally controls the forward lean of the boot.

Regarding the Declaration by Anthony O. DeRocco, see the last paragraph on page 2 of the advisory action mailed Jan. 14, 2003.

Rejection of Claims 57-59,65,68 and 69 under 35 U.S.C. 102 (b)

Appellant argues that "Spademan does not have a medial and a lateral cable, as recited in Claims 57 and 65. In direct contrast, Spademan has cables coming from only one side of the boot. Thus, Spademan has either two lateral cables or two medial cables, depending on whether the boot is for a right or left foot".

In response, the portion of the cable (17) that is predominately on the lateral side of the boot (as labeled in the marked-up copy attached) is the lateral side cable member and the portion of the cable that is on the medial side of the boot (as labeled) is the medial side cable member. It is not clear why applicant argues they are either two lateral cables or two medial cables.

Appellant argue that boot of Spademan is not a forward lean system. Appellant argues, "The system of Spademan is a dynamically adjustable cuff that responds to forward movement of the leg."

In response, all ski boots, predominantly, have the uppers leaning forward, see figure 2, and therefore are a forward lean system. The system of Spademan is an adjustable cuff assembly that the cable (17) surrounds the leg of the wearer attached to the upper cuff (3) and is connected to the lower shell (2) in the back of the shell and therefore naturally controls the forward lean of the boot. Moreover, see line 3 of the abstract and col. 5, lines 42-49, which teach about the "forward lean" of the boot.

Rejection of Claims 99-101 under 35 U.S.C. 102(b)

Appellant argues "that the second guide, indicated by the Examiner as being located on a lower front portion of the boot, is more closely aligned in height with the first guide that is located on the upper portion of the boot."

To the contrary, the second guide is lower than the first guide, see figure 1. The cable clearly is sloping slightly downward towards the front of the boot.

Appellant argues that the "second guide is clearly not on the same side as the first guide."

To the contrary, the second guide (the one of the two openings on the ankle support part (62) of the boot) is on the same side as the first guide, see figure 1 which shows this clearly. Figure 1 shows only one side of the boot.

Appellant argues that Ottieri does not describe a forward-lean system.


In response, all ski boots, predominantly, have the uppers leaning forward, see figure 1, and therefore are a forward lean system. The system of Ottieri has a cable surrounds the leg of the wearer attached to the shin cuff portion (16) and is connected to the heel spoiler (18) in the back of the shell and therefore naturally controls the forward lean of the boot.

For the above reasons, it is believed that the rejections should be sustained.

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Art Unit: 3728

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Respectfully submitted,

  
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Art Unit 3728

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April 24, 2003

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[54] **SPORT SHOE WITH A DYNAMIC  
ADJUSTABLE CUFF ASSEMBLY**

[76] Inventor: Richard G. Spademan, Box 6410,  
Incline Village, Nev. 89450

[21] Appl. No.: 109,611

[22] Filed: Jan. 4, 1980

**Related U.S. Application Data**

[63] Continuation-in-part of Ser. No. 886,946, Mar. 15,  
1978, and Ser. No. 50,436, Jun. 20, 1979.

[51] Int. Cl.<sup>3</sup> ..... A43B 5/04; A43B 11/00

[52] U.S. Cl. .... 36/121; 36/50

[58] Field of Search ..... 36/117, 118, 119, 120,  
36/121, 50

[56] **References Cited**

**U.S. PATENT DOCUMENTS**

3,313,046 4/1967 Werner et al. .... 36/121  
3,793,749 2/1974 Gertsch et al. .... 36/121

4,083,129 4/1978 Collombin et al. .... 36/117  
4,190,970 3/1980 Annovi ..... 36/117

Primary Examiner—Patrick D. Lawson  
Attorney, Agent, or Firm—Townsend and Townsend

[57] **ABSTRACT**

A sport shoe (1,30,50) is described provided with a cuff means (3,52) and means (17,57,58,70,71) responsive to forward lean coupled to said cuff means (3,52) for tightening said cuff means (3,52) about a leg enclosed thereby. In one embodiment the tightening means (17) is coupled to a cuff-mounted buckle means (10,31) for pulling cuff flap means (4,5) together with forward lean of the cuff means (5). In another embodiment a tongue member (53), in cooperation with the tightening means (57,58,70,71) pulls the cuff means (55,56) together with forward lean. In all of the embodiments forward and rearward lean dynamically adjust the fit of the cuff means (3,52) with respect to a leg enclosed thereby.

19 Claims, 15 Drawing Figures

